

II. Rejections under § 103(a)

A. *Matsunaga* in view of *Laurent*

The Examiner rejects claims 1, 2, 4-6, 8, 10, 16-26, 29-34, 36-56, and 60-68 under 35 U.S.C. § 103(a) as being unpatentable over US Patent Application Publication No. 2001/0054206 to Matsunaga et al. ("*Matsunaga*") in view of US Patent Application Publication No. 2002/0046431 to Laurent et al. ("*Laurent*"). Office Action, page 2. Specifically, the Examiner alleges that *Matsunaga* teaches a hair dyeing composition comprising a fluorescent dye of azomethine compound of formula (2), which is similar to the formula (F2) as recited in the rejected claims. *Id.* The Examiner admits that *Matsunaga* does not teach the at least one associative polymer as recited in the rejected claims. *Id.* at page 3. However, to remedy this deficiency, the Examiner alleges that because *Matsunaga* "suggests the use of cationic or amphoteric polymers in the hair dyeing compositions" (citing *Matsunaga*, page 3, paragraph 0024) and *Laurent* teaches a composition comprising cationic amphiphilic polymers such as cationic polyurethanes, it would have been obvious to modify *Matsunaga*'s composition by adding in *Laurent*'s cationic polymers. *Id.* at pages 3-4. Applicants respectfully disagree and traverse this rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met, including that there is some suggestion or motivation, either in the cited reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings. M.P.E.P. § 2143. The teaching or suggestion must be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Here, the Examiner has failed to point to any evidence of a suggestion or motivation to modify *Matsunaga*'s composition to arrive at the present invention as alleged by the Examiner. *Matsunaga* discloses a hair dye composition comprising an "azamethine" compound. *Matsunaga*, page 1, paragraph [007].

First, *Matsunaga* further teaches that its composition can also comprise cationic or amphoteric polymers, but this general teaching must be considered in context: specifically, *Matsunaga* lists polyol, polyol alkyl ether, cationic or amphoteric polymer or silicone as possible additives to improve cosmetic properties, but says nothing else about them. *Id.* at page 3, paragraph [0024]. There is no direction in this passage that would have motivated one of ordinary skill in the art to choose a cationic polymer from among the other choices of additives and include it into the composition in the first place.

Second, solely for purposes of argument, even if the cationic polymer were chosen, there is no evidence of a suggestion or motivation to choose *Laurent*'s cationic polymer and use it to modify *Matsunaga*'s composition as alleged by the Examiner. "Cationic polymer" as disclosed by *Matsunaga* is a broad genus, encompassing a countless number of polymers. The cationic amphiphilic polymer disclosed in *Laurent* is merely a small subset of this general category of "cationic polymer." There is no suggestion or motivation in either reference to choose any cationic polymer as a cosmetic additive for *Matsunaga*'s composition, let alone *Laurent*'s specific cationic amphiphilic polymer .

Therefore, this rejection is improper. As the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request this rejection be withdrawn.

B. *Matsunaga* in view of *Cottard*

The Examiner rejects claims 3, 7, 9, and 11-15 under 35 U.S.C. § 103(a) as being unpatentable over *Matsunaga* in view of US Patent Application Publication No. 2001/0023514 to Cottard et al. ("*Cottard*") Office Action, page 4. Specifically, the Examiner relies on *Matsunaga* as set forth above, but admits that *Matsunaga* does not teach the anionic and nonionic associative polymers as recited in the rejected claims. *Id.* To remedy this deficiency, the Examiner alleges that because *Matsunaga* "suggests the use of natural and synthetic polymers in the dyeing compositions" (citing *Matsunaga*, page 3, paragraph 0025) and *Cottard* teaches a composition comprising the anionic polymer and the nonionic polymer as recited in the rejected claims, it would have been obvious to modify *Matsunaga*'s composition by adding in *Cottard*'s anionic and nonionic polymers. *Id.* at page 5. Applicants respectfully disagree and traverse this rejection for at least the following reasons.

First, the Examiner has failed to point to any evidence of a suggestion or motivation to modify *Matsunaga*'s composition to arrive at the present invention as alleged by the Examiner. Specifically, in *Matsunaga*, page 3, paragraph [0025], natural or synthetic polymers are disclosed as an optional component in a general laundry list of other optional components which may also be added to the composition. There is no suggestion or motivation to choose a natural or synthetic polymer from this optional list, let alone to include it into the composition.

Second, solely for purposes of argument, even if a natural or synthetic polymer were chosen as an additive to be used in *Matsunaga*, there is no suggestion or motivation to choose as such an additive the specific anionic and nonionic polymers disclosed in *Cottard*. Indeed, "natural or synthetic polymers" includes a countless

number of polymers, and the Examiner has failed to point to any suggestion or motivation to choose the any anionic and nonionic polymers as disclosed in *Cottard*, let alone those polymers presently recited in the rejected claims.

Therefore, this rejection is improper. Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request this rejection be withdrawn.

C. *Matsunaga* in view of *Cottard* and further in view of *Giuseppe*

The Examiner further rejects claim 35 under 35 U.S.C. § 103(a) as being unpatentable over *Matsunaga* in view of *Cottard* and further in view of US Patent No. 5,744,127 to Giuseppe et al. ("*Giuseppe*"). Office Action, page 6. Applicants respectfully disagree and traverse this rejection for at least the following reasons.

First, claim 5 depends on claim 1, which is rejected under § 103(a) over *Matsunaga* in view of *Laurent*, instead of *Cottard*. *See id.* at page 2. The Examiner apparently erred in relying on *Cottard* for this rejection. Therefore, this rejection is improper.

Second, *Giuseppe* is merely relied on for its teaching of a composition, which can be used as both a hair shampoo and a hair dyeing composition. *See id.* at page 6. *Giuseppe* does nothing to cure the deficiencies of the § 103(a) rejections as set forth above in subsections A and B. Therefore, for this additional reason, this rejection is improper.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request this rejection be withdrawn.

III. Allowable Subject Matter

Applicants acknowledge, with appreciation, the indication of allowable subject matter in claims 27, 28, and 57-59, and note that such claims are objected to as based on rejected parent claims. See Office Action, page 7. Despite the indication that they would be allowed if rewritten in independent form, Applicants have decided to keep these claims in dependent form for the reasons discussed above, e.g., that the rejections of claims 1-26, 29-56, and 60-68 are improper and should be withdrawn.

IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims. If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call Applicants' undersigned representative at (202) 408-4218.

If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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